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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
034300-000172

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Signature

Typed or printed

Name Michelle R. Crosby

Application Number
09/954,612

Filed
September 12, 2001

First Named Inventor
Ping LIU

Art Unit
2115

Examiner
Chun Cao

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.

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Attachment to PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 9, 10, 12, 13, 16-23 and 25-29 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Fuller et al., U. S. Patent 5,768,605 (hereinafter referred to as Fuller) in view of Johnson et al., U.S. Patent 6,573,868 (hereinafter referred to as Johnson) among which claims 9, 16 and 25 are independent claims. The Applicant traverses the rejection and hereby requests a pre-appeal review of rejected independent claims 9, 16 and 25.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Id. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Id. In addition, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead or teach away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983).

In the present case, the Examiner admits in the Office Action that Fuller fails to disclose that the host device does not provide power to the antenna in response to the removed signal. However, the Examiner argues that Johnson discloses a switch to generate a signal base on the position of an antenna whether or not to supply power to the antenna. The Examiner thereby makes the argument that it would have been obvious to one skilled in the art to combine the teachings of Fuller and Johnson, because together they teach a communication PC card and Johnson would improve the performance of Fuller's system by further reducing power consumption of Fuller's system. The Applicant respectfully disagrees.

The Applicant's specification recites a mechanism for providing zero power control of a computer peripheral. In an embodiment, the mechanism includes a switch electrically connected to a card detecting pin of the host device. The switch is operated by a retractable antenna of the

card in an embodiment. For example, when the antenna is in a retracted position, the switch generates a "removed" signal to the card detecting pin. The "removed" signal simulates that the computer peripheral has been removed from the host device such that the operating software of the host device will not supply power to the card. On the other hand, for example, when the switch detects the antenna in the extended state, the switch will generate an "inserted" signal to the card detecting pin. In an embodiment, the "inserted" signal informs the host device operating system that a card has been inserted and then power is applied to the card. (Applicant's Specification, Abstract).

The primary reference replied upon by the Examiner, Fuller, discloses a PCMCIA card which has a switch, whereby a connector 364 receives a communication cable 368 when the connector 364 is at an extended position. Fuller describes that when the connector 364 is in the extended position, node A 382 is decoupled from node B 381, whereby voltage is provided to the card 340. In contrast, when the connector 364 is in the retracted position, node A 382 is coupled to node B 381, whereby voltage is not provided to the card 340. As recognized in the Office Action, Fuller does not recite an antenna nor that the inserted or removed signal is based on the position of the antenna.

The secondary reference relied upon by the Examiner, Johnson, only discloses an antenna which is able to move between an extended and retracted position, whereby power is provided to the antenna when the antenna is extended. Johnson also states,

[a]s shown in FIGS. 6A and 6B, a control switch 150 is used to control the operation of the antenna system. For example, the control switch 150 desirably prevents the antenna system from receiving or transmitting wireless information when the antenna is in the retracted position and allows wireless communication when the antenna is in the extended position. Preferably, the control switch 150 governs the operation of the antenna system automatically by controlling the flow of electrical power to the antenna or antenna system. Advantageously, the control switch 150 still allows the other features of the communications card and/or electronic device to be utilized even though the antenna is non-functional.

(Johnson, Col. 12, Lines 49-64) (Emphasis Added).

In contrast, Applicant's Claim 9 recites, among other things, that the switch causes the host device to terminate power to the peripheral device and antenna. In addition, Claim 16 recites, among other things, that the host device does not power the peripheral device and the antenna when the antenna is retracted. Further, Claim 25 recites, among other things, that host

device does not provide power to the peripheral device and the antenna in response to the removed signal.

One skilled in the art, upon reading Johnson, would not find any motivation to combine Johnson with another prior art reference, because Johnson expressly teaches away from the limitation of terminating power to the peripheral device and the antenna, as in Claims 9, 16 and 25. Contrary to the Examiner's argument, Johnson expressly discloses that the communications card is still able to receive power after the antenna has been retracted and the card receives the signal to no longer provide power only to the antenna itself. (Johnson, Col. 4, Lines 4-10; Col. 12, Lines 58-60). One skilled in the art would not find motivation to use Johnson in reaching the invention in Claims 9, 16, and 25 considering that a card utilizing the teachings of Johnson will still drain power from the host computer (e.g. laptop computer) when the antenna is not operating. This may be particularly undesirable for a user using a wireless modem card in which the only function of the card is to provide wireless communication and nothing else. The user utilizing this type of card will not want the card to continue to operate and drain power from a laptop battery when the antenna is retracted and no wireless communications are occurring.

The Applicant understands that the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives, because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed. In re Fulton, 391 F.3d 1195, 1201 (Fed. Cir. 2004). However, that is not the case with the Johnson reference. Johnson does not provide more than one alternative to where power is terminated to both the card and the antenna. In fact, Johnson further supports the notion that power continues to be delivered to the card when the antenna is retracted by disclosing other embodiments (Figures 9-12B) wherein an integrated RJ series connector jack, a modular antenna or a combination thereof is connected to the card and continues to operate when the antenna is retracted. Thus, Johnson does not provide the motivation to one skilled in the art to use Johnson with another reference in reaching the inventions in Claims 9, 16 and 25. Considering that Johnson taken as a whole teaches away from the inventions claimed in Claims 9, 16 and 25, it is improper to use Johnson in attempting to establish a prima facie case of obviousness. Accordingly, the 103 obviousness rejection is improper, and should be withdrawn. For at least these reasons, Claims 9, 16, and 25 are allowable over Fuller and Johnson, individually or in combination.